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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,270

03/26/2004

Luis Monsalud JR.

BW-443-1

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27868

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03/08/2007

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EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/811,270

Applicant(s)

MONSALUD ET AL.

Examiner

Jason L. Lazorcik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004 and 26 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/26/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS Filed 11/10/2005 and 09/13/2006.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a process for making a tobacco sheet, classified in class 131, subclass 370.
- II. Claims 13-33, drawn to a tobacco sheet and cigarette comprising said sheet, classified in class 131, subclass 357.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I) and (II) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product tobacco sheet could be manufactured by a materially different method such as by dust impingement.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Charles Sherman on February 2, 2007 a provisional election was made without traverse to prosecute the invention of the product tobacco sheet and cigarette, claims 13-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 to 32 rejected under 35 U.S.C. 102(b) as being anticipated by Brandel (US 2,769,734).

Brandel teaches (see example four, Column 6) a tobacco paper comprising 15.8% Sodium Alginate, 4.7% glycerine, 15.8% paper pulp fiber (e.g. wood pulp), and 63.5% Tobacco. The Brandel tobacco paper is understood to provide a tobacco paper comprised of *about* 5 to 15% wood pulp, *about* 13.5% glycerine as a humectant [**Claim 26, 27, 28**], *about* 27% sodium alginate as a binder [**Claim 29, 30, 31**], and *about* 15-

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40% tobacco. The ratio of tobacco to binder agent is approximately 4:1 which is understood to be in a ratio of approximately 1:1 [Claim 32]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13 to 22, 24, 25, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crooks (US 6,606,999 B2) in view of Bandel (US 2,769,734). Crooks (US 6,606,999 B2) teaches "a smoking article having a reduced ignition propensity and an increased puff count. The smoking article comprises a rod of smokable material within a wrapper having a strip of paper material forming a region having at least two paper layers aligned substantially parallel to the longitudinal axis of the smoking article." (Abstract) As evidenced by the instant reference figure XX, the strips are inserted into a cigarette adjacent a column of tobacco [Claim 32].

Crooks continues by teaching that this “paper strip material is made from paper...or it may be tobacco paper with similar characteristics.” and that in some contemplated embodiments, a plurality of longitudinal strips are incorporated into the inner wrapper. Column 3, lines 31-62) The reference further discloses that the spacing and location of the plurality of strips can be located based upon the number of strips in the smoking article (Column 4, Lines 1-3). Although not expressly taught by the instant reference, it would have been obvious to one of ordinary skill in the art at the time of the invention of locate the strips “equidistant from each other” around the circumference of the column of tobacco in order to promote a uniform burn profile in the resultant cigarette [**Claim 33**].

Finally, Crooks teaches that flavorants like menthol can be incorporated into the cigarette “using techniques familiar to the skilled artisan” (Column 5, lines 14-19). Although Crooks is silent regarding incorporating a specific mass fraction of methanol flavorant, one of ordinary skill in the art would be fully capable of determining an appropriate of said flavorant based on the desired flavoring intensity [**Claim 14, 24**]. It is therefore asserted that absent any unexpected results to the contrary, Applicants claim limitation wherein menthol is approximately 20% by weight of the inner wrap is obvious over the prior art teachings [**Claim 15, 25**].

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Crooks is silent regarding the specific details of the inner tobacco paper strips or "partial inner wrap material". Bandel (US 2,769,734) teaches (see example four, Column 6) a tobacco paper comprising 15.8% Sodium Alginate, 4.7% glycerine, 15.8% paper pulp fiber (e.g. wood pulp), and 63.5% Tobacco. The reference indicates that the inventive tobacco paper is easily worked into a smoking product due to its natural tobacco characteristics of taste, color, and aroma. The Bandel tobacco paper is understood to provide a tobacco paper comprised of about 5 to 15% wood pulp, about 13.5% glycerine as a humectant [**Claim 16, 17, 18**], about 27% sodium alginate as a binder [**Claim 19, 20, 21**]. The ratio of tobacco to binder agent is approximately 4:1 which is understood to be in a ratio of approximately 1:1 [**Claim 22**]. Due to its natural tobacco-like properties, the Bandel tobacco sheet would be an obvious choice for the tobacco paper strips in the Crooks cigarette.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL


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